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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,442	08/14/2003	Rene Francois Monet	BR6.P29	2471
21792	7590	08/06/2004	EXAMINER	
STRATTON BALLEW 213 S 12TH AVE YAKIMA, WA 98902			HWU, JUNE	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/642,442

Applicant(s)

MONET, RENE FRANCOIS

Examiner

June Hwu

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 1661

DETAILED ACTION

Applicant's claim for benefit of priority based on application number 60/404,217 filed August 15, 2002 has been acknowledged.

Drawing

The disclosure is objected to under 37 CFR 1.165(a) because the drawing does not show all the distinctive characteristics of the claimed plant capable of visual representation. Applicant should show a cross section of the fruit including its flesh, stone and cavity. Additional photograph is required.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In plant application filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1661

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) because the specification presents less than a full and complete botanical description and the characteristics which distinguish over related known varieties.

More specifically:

- A. Age and growing conditions of the observed tree should be disclosed in the specification. Correction is required.
- B. The specification does not "particularly point out where and in what manner the variety of plant has been asexually reproduced". Correction is required.
- C. Applicant must set forth in the specification a brief description how the new variety is distinguished from its parents and related known cultivars.

Art Unit: 1661

D. Applicant should set forth in the specification the rootstock onto which the claimed plant was propagated and grown, and provide information as to the plant when grown on its own roots, if available.

E. Applicant should set forth in the specification a description of the tree size (height and spread) and cold hardiness or heat/cold resistance of providing as complete a description of the observed plant as is reasonably possible.

F. Applicant should set forth in the specification a botanical description of the trunk such as diameter (measured at a given height above soil level), lenticels (color designation, size, shape), bark color, and bark texture in the interest of providing as complete a description of the observed plant as is reasonably possible. Corrections are necessary.

G. Applicant should set forth in the specification a botanical description of the branch size (diameter), surface texture, color designation with reference to an employed color chart, general color terms of the branch anthocyanin, lenticels (shape, average size and color designation) and average length of internodes in the interest of providing as complete a description of the observed plant as is reasonably possible. Corrections are necessary.

H. Applicant should set forth in the specification a botanical description of the leaf size (length and width), base and apex shapes, form, surface texture, color designation of the upper and lower surfaces with reference to an employed color chart, venation pattern, margin type, petiole (length, diameter, color designation), leaf gland (size, color designation), and leaf stipules (length, width, shape, margin type, color designation) in the interest of providing as

Art Unit: 1661

complete a description of the observed plant as is reasonably possible. The terms “long” (page 2, line 16), “medium” (page 2, line 17), and “short” (page 3, line 3) are vague and insufficient. Additionally, the color description in general color term “green” (page 3, line 1) is vague and does not sufficiently describe the color designation with reference to an employed color chart. Corrections are necessary.

I. Applicant should set forth in the specification a botanical description of the flower bud size (length and diameter), surface texture, color designation with reference to an employed color chart, and cold tolerance in the interest of providing as complete a description of the observed plant as is reasonably possible.

J. Applicant should set forth in the specification a botanical description of the flower type, size (length and width), petal (size, margin type, color designation, shape), number of flowers per cluster, sepals (size, color designation, surface texture), blooming time, date of first and last blooms at a give time of culture, and fragrance in the interest of providing as complete a description of the observed plant as is reasonably possible. Corrections are necessary.

K. Applicant should set forth in the specification a botanical description of the reproductive organs such as color designation of the anthers, filament, style, and ovary, size of pistil, stamens, ovary, and pollen in the interest of providing as complete a description of the observed plant as is reasonably possible.

L. Applicant should set forth in the specification the average size of the pistil and stamens.

Art Unit: 1661

M. Applicant should set forth in the specification a botanical description of the fruit maturity (date of first and last picking at a given time of culture), size, average weight, suture, ventral surface form, base shape, skin (texture, tendency to crack, ground and over colors with reference from a recognized color chart), flesh color designation, anthocyanin coloration around the stone in general color terms, stem cavity (shape, size), and pit cavity (size). The terms "small" (page 3, line 8), "shallow" (page 3, line 13), and "broad" (page 3, line 14) are vague and insufficient. Additionally, the color description in general color term "orange yellow" (page 3, line 15 and page 4, line 2) and terms like "present" (page 3, line 16), "medium red" (page 3, line 17), "solid flush" (page 3, line 18), and "large" (page 3, line 19) are vague and does not sufficiently describe the color designation with reference to an employed color chart. Corrections are necessary.

N. Applicant should set forth in the specification a botanical description of the stone type, size (length, width, diameter), form, base and apex shape, surface texture, color designation with reference to an employed color chart, and kernel (size, shape, color designation). Term such as "small" (page 4, line 10) and "medium" (page 4, line 12) are vague and insufficient. Corrections are necessary.

O. If additional information is available relative to plant/fruit disease and pest resistance/susceptibility such should be set forth in the specification or if not observed state – none observed.

P. Applicant should set forth in the specification a description of the shipping quality of the fruit, keeping quality of the fruit, and flavor (sweetness, acidity, Brix level) of the observed fruit in

Art Unit: 1661

the interest of providing as complete a description of the observed plant as is reasonably possible. Corrections are necessary.

Q. Applicant should set forth in the specification the chilling requirement of the claimed plant.

R. Applicant should set forth in the specification the differences between co-pending application 10/642,441 and this instant application because of their phenotypic similarities.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

Claim Rejections

35 USC § 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1661

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as the plant described and illustrated does not patentably distinguish over the plant forming the basis of U.S. Plant Patent No. 12,008. Applicant bears the burden of clearly and precisely describing the characteristics that define and distinguish the new variety (*In re Greer* 179 USPQ 301). The application is not patentably distinct from the enclosed patent in that a complete botanical characteristic for the tree height and spread, trunk diameter, leaf size, flower size, fruit, picking times, disease and pest resistance of the claimed fruit, for example, is not enclosed. The above listing may not be complete. Applicant should carefully review the disclosure and import additional information that would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Conclusion

No claim is allowed.

Future Correspondence

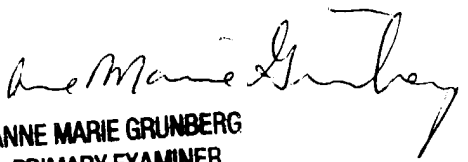
Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 1661

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH


ANNE MARIE GRUNBERG
PRIMARY EXAMINER